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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,523	03/19/2004	Thomas M. Verrengia	17073	7530

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EXAMINER

CHIU, RALEIGH W

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/804,523

Applicant(s)

VERRENGIA, THOMAS M.

Examiner

Raleigh Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC §§ 102 and 103***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 5, 6 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,733,213 (Colarusso) in view of U.S. Patent Number 5,597,161 (Bellehumeur et al., hereinafter Bellehumeur).

Regarding claims 1, 5, 6 and 21, Figure 22 of Colarusso shows a hockey puck with a disc-shaped body 140 with a central opening 179 and a plurality of peripheral openings 156. Roller 100 corresponds to the recited central plug. Runners 190 are

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disposed in the peripheral openings but each runner does not extend above both the upper and lower surfaces. However, it would have been obvious to one of ordinary skill in the art to place a single plug in each of the peripheral openings in view of Bellehumeur who teaches, in Figures 7-10 and 15-17, the equivalence between discrete and separate plugs in a hockey puck.

Regarding claim 2, Colarusso discloses a rubber puck body (column 8, lines 13-15) with high-density rubber or Teflon<sup>TM</sup> plugs (column 10, lines 22-25; column 12, lines 41-47).

With further regard to claim 21, Figures 12 and 14 of Bellehumeur further show that no portion of the plugs is disposed at the circumference.

Regarding claim 3, Colarusso discloses the use of Delrin<sup>TM</sup>, a known acetal homopolymer, as a plug material. Further, Bellehumeur discloses that puck bodies are known in the hockey art to be made from elastomers; it would have been obvious to one of ordinary skill in the art to use a specific known elastomer, such as SBR elastomer, as a matter of routine experimentation.

4. Claims 4, 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colarusso and Bellehumeur as applied above in view of U.S. Patent Number 6,152,842 (Licursi).

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Regarding claim 4, it would have been obvious to one of ordinary skill in the art to size the peripheral plugs to cover a substantial portion of the puck periphery in view of Licursi who teaches that such a construction allows for better puck stability over an irregular surface. See Licursi at Figures 3a-3d and column 5, lines 24-35.

Regarding claims 9 and 19, as one of ordinary skill in the art would expect that larger peripheral plugs would improve puck stability even more, it would have been obvious to have the plugs comprise a surface area greater than the surface area of the puck.

5. Claims 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colarusso and Bellehumeur as applied above in view of U.S. Patent Number 5,816,965 (Kotler).

Regarding claims 7 and 8, although Colarusso shows peripheral plugs with a circular cross-section, it would have been obvious to one of ordinary skill in the art to substitute plugs with an oval cross-section in view of Kotler in order to play with a puck that has different performance characteristics. See Kotler at Figure 7b and column 6, lines 18 *et seq.*

Regarding claim 10, Figure 6 of Kotler shows the middle of the peripheral plugs 40 to have a notch 50; such a notch

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corresponds to the recited plug opening and mates with the puck body. Also, see Kotler at column 5, lines 40-55.

6. Claims 11 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Colarusso as applied above.

Regarding claim 11, Figure 16 shows the recited blank 140 with central opening 142 and peripheral openings 156.

Regarding claim 17, roller 100 corresponds to the recited central plug.

7. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colarusso as applied above in view of Licursi as applied above.

Regarding claim 12, it would have been obvious to one of ordinary skill in the art to size the peripheral plugs to cover a substantial portion of the puck periphery in view of Licursi who teaches that such a construction allows for better puck stability over an irregular surface. See Licursi at Figures 3a-3d and column 5, lines 24-35.

Regarding claim 16, as one of ordinary skill in the art would expect that larger peripheral plugs would improve puck stability even more, it would have been obvious to have the plugs comprise a surface area greater than the surface area of the puck.

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8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colarusso as applied above in view of Kotler as applied above.

Regarding claims 14 and 15, although Colarusso shows peripheral plugs with a circular cross-section, it would have been obvious to one of ordinary skill in the art to substitute plugs with an oval cross-section in view of Kotler in order to play with a puck that has different performance characteristics.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Licursi.

Figures 4-6 of Licursi show a puck with a plurality of peripheral plugs 24 covering a substantial portion of the puck periphery for better puck stability. As one of ordinary skill in the art would expect that larger peripheral plugs would improve puck stability even more, it would have been obvious to have the plugs comprise a surface area greater than the surface area of the puck.

10. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Bellehumeur.

Figures 12-14 show a peripheral plug 19 disposed in each peripheral opening such that no portion is disposed at the circumference of the puck body.

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**Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

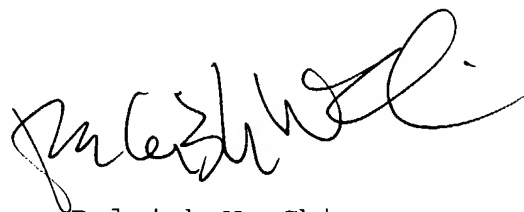
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (703) 308-2247. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (703) 308-1513.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu  
Primary Examiner  
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